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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,967	01/15/2002	Kevan M. Shokat	051538-5001-01	3019
9629	7590	01/13/2005	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			HARLE, JENNIFER I	
		ART UNIT	PAPER NUMBER	
		1654		

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT      PAPER

01052005

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Commissioner for Patents

See attached.

## DETAILED ACTION

Claims 1-6 and 61-76 were pending. Applicant has canceled claims 1-76 and submitted new claims 77-104. However, these claims are deemed directed to non-elected subject matter, as set forth below.

### *Response to Amendment*

The reply filed on December 9, 2004 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s): the newly submitted claims are directed to non-elected subject matter. Applicant argues that the newly submitted claims are directed to the same invention, i.e. selective inhibitors, just that the words chosen to describe the inhibitors are not the same as those used to describe the inhibitors in the original claims and that original claim 1 did not stat that the inhibitor has not catalytic activity of a wild-type enzyme but is directed to an inhibitor that inhibits a mutant enzyme differently from the way it inhibit the corresponding wild-type enzyme. See pg. 6, 3<sup>rd</sup> full paragraph and pp. 6-7 4<sup>th</sup> paragraph.

The examiner respectfully disagrees. The wording of the newly submitted claims 77-104 are directed to non-elected inventions that are independent or distinct from the invention originally claimed for the following reasons: As previously explained, Applicant has changed the claimed inhibitor. Originally, the claims were directed to an inhibitor that does **not** inhibit a catalytic activity of a **wild-type enzyme** **but** inhibits the same catalytic activity of the corresponding **mutant enzyme** – zero inhibition of a catalytic activity of **wild-type enzyme** and **the wild-type enzyme and mutant enzyme are functionally identical**. However, the inhibitor, as now claimed has 15-15,000 fold greater selectivity for a mutant enzyme as compared to its selectivity for the corresponding wild-type enzyme and this changes the claimed inhibitor. First,

the inhibitor has changed as it now has a specific range of activity toward the mutant type enzyme, i.e. selectivity, and albeitly some activity toward the other, the wild-type, i.e. **both not zero**. This also changes the inhibitor as previously claimed because they are now no longer functionally identical, if one has greater selectivity than the other, they can not be functionally identical enzymes. Thus, the invention has been changed. See Previous Office Action, pages 2-3. The examiner notes references made to a discussion with the previous examiner Jon Weber during a telephone interview. The examiner has reviewed the complete file history and is unable to find any contemporaneous documentation of that interview except a thank you for suggestions to amend the claims. There is no formal interview summary. The substance of the interview was never made of record, i.e., any specific recommendations of claim amendments are not present. Moreover, the examiner has spoken with Jon Weber, and he does not recall making any specific recommendations to amend the claims to overcome the rejections. His recollection is more generic about a discussion of the nature of the invention.

Applicant also argues that they have not received a complete action on the merits for this application. The examiner respectfully disagrees. A complete action was issued on the merits on March 13, 2004. Applicant is advised to put the claims back into the form that they were in before the amendment was made. Since Applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 77-104 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. See 37 CFR 1.111. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice,

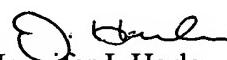
whichever is longer, within which to supply the omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer I. Harle whose telephone number is (571) 272-2763. The examiner can normally be reached on Monday through Thursday, 6:30 am to 5:00 pm.,

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer I. Harle  
Examiner  
Art Unit 1654

December 28, 2004